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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,008	03/10/2004	Tse-Hao Ko	KO53	4259
1444 7590 03/09/2009 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
PIZIALI, ANDREW T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/796,008

**Applicant(s)**

KO, TSE-HAO

**Examiner**

Andrew T. Piziali

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/10/04 & 10/5/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/26/2008 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,950,533 to McCullough in view of USPN 3,914,393 to Ram in view of USPN 4,248,036 to Barron.

McCullough discloses a flame retardant woven, densified carbon fabric filter wherein the carbon fibers have a carbon content of at least 65%, a nitrogen content of from 10 to 20%, and a limiting oxygen index of at least 40 (see entire document including column 2, lines 51-68, column 3, lines 56-6, column 4, lines 14-17 and 51-57, and column 5, lines 22-31).

McCullough does not appear to mention the oxygen content of the carbon fibers, but Ram discloses that it is known in the carbon fiber art to make carbon fibers with an oxygen content of at least about 7% (see entire document including column 3, lines 32-40). Ram also discloses that it is known in the art to carbonize at a temperature of about 300°C to 3100°C to produce graphitic carbon (paragraph bridging columns 3 and 4). It is noted that graphitic carbon has a density of over 1.68 g/ml (about 2.2 g/ml). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the carbon fibers from any suitable carbon fiber material, such as that disclosed by Ram, because the carbon fibers disclosed by Ram are heat resistant and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

The substitution of known equivalent structures involves only ordinary skill in the art. *In re Fout* 213 USPQ 532 (CCPA 1982); *In re Susi* 169 USPQ 423 (CCPA 1971); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *In re Ruff* 118 USPQ 343 (CCPA 1958). When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. **KSR v. Teleflex.**

McCullough does not appear to mention the fabric density, but McCullough does disclose that the fabric may be used as a hose covering (column 5, lines 22-31). Barron discloses that it is known in the hose covering art (see entire document including column 1, lines 33-46) to construct a woven fabric with a warp density of 27 to 32 and a weft density of 24 to 32 (see Examples). Barron specifically mentions a 27x24 fabric density (Example 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric in any suitable fabric density, such as a warp density of 27 to 32 and a weft density of 24 to 32, motivated by the expectation of successfully practicing the invention of McCullough and because it is within the general skill of a worker in the art to select a known fabric density on the basis of its suitability and desired characteristics.

Regarding the claimed product-by-process limitation (forming the carbon fabric from oxidized fibers of polypropylene), it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-

obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Regarding the claimed wave shielding property, considering that the carbon fabric taught by the applied prior art is substantially identical to the claimed carbon fabric, it appears that the carbon fabric inherently possesses the claimed wave shielding property.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

4. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,950,533 to McCullough in view of USPN 4,861,809 to Ogawa in view of USPN 4,248,036 to Barron.

McCullough discloses a flame retardant woven, densified carbon fabric filter wherein the carbon fibers have a carbon content of at least 65%, a nitrogen content of from 10 to 20%, and a limiting oxygen index of at least 40 (see entire document including column 2, lines 51-68, column 3, lines 56-6, column 4, lines 14-17 and 51-57, and column 5, lines 22-31).

McCullough does not appear to mention the oxygen content of the carbon fibers, but Ogawa discloses that it is known in the carbon fiber art to make carbon fibers with an oxygen content of 3 to 10% (see entire document including column 2, lines 47-64). Ogawa also discloses that it is known in the art to use carbon fibers with a density of at least 1.5 g/cm<sup>3</sup> (at least 1.5 g/ml) (column 3, lines 11-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the carbon fibers from any suitable carbon fiber material, such as that disclosed by Ogawa, because the carbon fibers disclosed by Ogawa possesses low heat conductivity and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

The substitution of known equivalent structures involves only ordinary skill in the art. *In re Fout* 213 USPQ 532 (CCPA 1982); *In re Susi* 169 USPQ 423 (CCPA 1971); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *In re Ruff* 118 USPQ 343 (CCPA 1958). When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. **KSR v. Teleflex.**

McCullough does not appear to mention the fabric density, but McCullough does disclose that the fabric may be used as a hose covering (column 5, lines 22-31). Barron discloses that it is known in the hose covering art (see entire document including column 1, lines 33-46) to construct a woven fabric with a warp density of 27 to 32 and a weft density of 24 to 32 (see Examples). Barron specifically mentions a 27x24 fabric density (Example 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric in any suitable fabric density, such as a warp density of 27 to 32 and a weft density of 24 to 32, motivated by the expectation of successfully practicing the invention of McCullough and because it is within the general skill of a worker in the art to select a known fabric density on the basis of its suitability and desired characteristics.

Regarding the claimed product-by-process limitation (forming the carbon fabric from oxidized fibers of polypropylene), it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-



obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Regarding the claimed wave shielding property, considering that the carbon fabric taught by the applied prior art is substantially identical to the claimed carbon fabric, it appears that the carbon fabric inherently possesses the claimed wave shielding property.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

#### ***Response to Arguments***

5. Applicant's arguments filed 11/26/2008 have been fully considered but they are not persuasive.

The applicant asserts that Ram teaches that the fibers must be carbonized at a temperature of below 300°C so as to prevent evolution of hydrogen cyanide gas. The examiner respectfully disagrees. Ram discloses that it is known in the art to carbonize at a temperature of about 300°C to 3100°C to produce graphitic carbon (paragraph bridging columns 3 and 4). In addition, even

though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter.

In response to applicant's argument that the applied prior art fails to teach or suggest using the fabric for magnetic shielding, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that no motivation exists to combine the references because McCullough, Ram and Ogawa are allegedly nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McCullough, Ram and Ogawa are each in the field of applicant's endeavor, which is carbon fibers. More specifically, Ram, Ogawa, and applicant's invention relate to the conversion of synthetic material into carbon fibers while both McCullough and applicant's invention relate to carbon fiber fabrics.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/  
Primary Examiner, Art Unit 1794